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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Beach et al.

Application No.: 09/662,414

Confirmation No.: 9962

Filed: September 14, 2000

Art Unit: 3621

For: SYSTEM FOR VOUCHER OR TOKEN
VERIFICATION

Examiner: K. Abdi

APPEAL BRIEF

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Appeal Brief is being filed more than two months after the Notice of Appeal filed in this case on September 19, 2005, and is in furtherance of the Notice of Appeal. In accordance with Section 41.37(e), the time period for filing this Appeal Brief has been extended under the provisions of Section 1.136.

The fees required under Section 1.136(a)(i) and Section 41.20(b)(2) are dealt with in the accompanying TRANSMITTAL OF APPEAL BRIEF.

This brief contains items under the following headings as required by 37 C.F.R. § 41.37 and M.P.E.P. § 1206:

- I. Real Party In Interest
- II. Related Appeals and Interferences
- III. Status of Claims

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- IV. Status of Amendments
- V. Summary of Claimed Subject Matter
- VI. Grounds of Rejection to be Reviewed on Appeal
- VII. Argument
- VIII. Claims
- IX. Evidence
- X. Related Proceedings

Appendix A Claims

I. REAL PARTY IN INTEREST

The real party in interest for this appeal is:

Coinstar, Inc.

II. RELATED APPEALS, INTERFERENCES, AND JUDICIAL PROCEEDINGS

There are no other appeals, interferences, or judicial proceedings that will directly affect, be directly affected by, or have a bearing on the Board's decision in this appeal.

III. STATUS OF CLAIMS

A. There are 41 claims pending in the application.

B. Current Status of Claims

- 1. Claims canceled: 42;
- 2. Claims withdrawn from consideration but not canceled: none;
- 3. Claims pending: 1-41;
- 4. Claims allowed: none;
- 5. Claims rejected: 1-41.

C. Claims On Appeal

The claims on appeal are claims 1-41.

IV. STATUS OF AMENDMENTS

Applicant did not file an Amendment After the Final Rejection mailed May 19, 2005.

V. SUMMARY OF CLAIMED SUBJECT MATTER

There are various types of vouchers and tokens (such as printed tokens) which are used in or sold at retail stores. These vouchers and tokens can be used for a cash equivalent, event or travel tickets, public transportation, gift certificates, telephone calling cards, and the like. One problem with these vouchers and tokens is that they can be illicitly copied or otherwise forged, and the forgeries can be presented for redemption in order to cheat the participating business. Accordingly, there is a desire to verify the vouchers or tokens prior to redemption. (Specification, 1:5-10.)

Certain coin-counting machines count a customer's coins and provide a voucher or token redeemable for cash or merchandise, e.g., from a hosting grocery store. The cash value of the voucher or token is typically equal to the total of coins input into the coin-counting machine, minus a service fee. The voucher or token is generally printed on paper that typically includes security features, which are designed to deter forgery. These security features can include watermarks, holograms, magnetic strips, colored printing, or other techniques. (Specification, 1:11-16.)

When a voucher or token is presented to a cashier for redemption, the cashier typically checks the security features of the voucher or token for indications of a forgery. As can be appreciated, training is required so that the cashier can efficiently validate the voucher or token prior to redemption. Additionally, the capabilities of forgers are increasing in lock-step with the addition of new security features such that forged vouchers or tokens are a constant threat to participating businesses. (Specification, 1:17-23.)

The need for trained cashiers to recognize forged vouchers or tokens limits the ability for cross-redemption of the vouchers or tokens. For example, it may be impractical to redeem a voucher or token printed by a coin-counting machine in a grocery store at a neighboring store in a strip mall. Although customers would like greater freedom on where to redeem vouchers or tokens, cross-redemption at other stores would require the cashiers at all participating businesses to be well trained in forgery recognition. Unfortunately, most

cashiers are not well trained, and can not be relied upon to correctly validate security features. Additionally, cross-redemption increases the risk of multiple fraudulent redemptions. For example, in a multiple redemption situation, a valid voucher or token could be copied and presented at many participating businesses in quick succession, such that the potential risk to participating businesses is magnified. (Specification, 1:24-2:8.)

A. Claim 1

Embodiments of the present invention provide methods and systems for verifying vouchers or tokens prior to redemption. (See, e.g., Specification, 3:8.) Independent claim 1, for example, is directed to a method for verifying a voucher or token. (See, e.g., Specification, Figure 5 and related text at 7:20-8:19.) The method includes recording a code associated with the voucher or token, and scanning the voucher or token to retrieve the code at a cashier's station. (See, e.g., Specification, 7:25-8:6.) The method further includes querying a voucher or token database for information associated with the code, and determining whether the voucher or token is valid, using the information. (See, e.g., Specification, 8:8-19.) Claim 1 further states that the cashier's station uses a first communication link coupled to a back room computer, but the querying step uses a second communication link different from the first communication link. (See, e.g., Specification, Figures 1 and 2 and related text at 4:18-20; 5:5-17.)

B. Claim 5

Independent claim 5 is directed to a method for verifying a voucher or token, and includes features at least generally similar to corresponding features of claim 1. For example, the method of claim 5 includes recording a code associated with the voucher or token, scanning the voucher or token to retrieve the code at a cashier's station, and querying a voucher or token database for information associated with the code. Claim 5 differs from claim 1, however, in that claim 5 further recites that the querying step includes querying a kiosk which includes at least a portion of the voucher or token database. (See, e.g., Specification, Figure 4, and related text at 6:27-7:11.)

C. Claim 13

Independent claim 13 is directed to a system which verifies a voucher or token. (See, e.g., Specification, Figures 1-4, and related text at 4:17-7:11.) The system includes a cashier's station, which uses a first communication link with a back room computer. (See, e.g., Specification, Figures 1 and 2, and related text at 5:5-12.) The system further includes a voucher or token database and a recognition subsystem. The voucher or token database stores at least one of a code and a value associated with the voucher or token. (See, e.g., Specification, Figure 4, and related text at 6:27-7:26, and 8:9-23.) The recognition subsystem reads the code from the voucher or token. (See, e.g., Specification, Figures 1 and 3, and related text at 5:26-13.) In addition to the foregoing features, the system of claim 13 also includes first and second transceivers which form a second communication link, different from the first communication link. Specifically, the second communication link couples together the voucher or token database, and the recognition subsystem. (See, e.g., Specification, Figure 1 showing, e.g., a first antenna 128 on the voucher or token recognition subsystem 112 and a second antenna 132 on the kiosk 116, and related text at 4:25-5:4; and Figures 3 and 4, and related text at 6:14-26.)

D. Claim 18

Independent claim 18 is directed to a system which verifies a voucher or token, and includes features at least generally similar to corresponding features of independent claim 13. For example, the system of claim 18 includes a cashier's station, a recognition subsystem, and a voucher or token database. The cashier's station uses a first communication link with a back room computer, while the recognition subsystem is coupled to the voucher or token database by a second communication link formed from first and second transceivers. The system of claim 18 differs from that of claim 13, however, in that it also includes a kiosk that contains a coin-counting mechanism and at least part of the voucher or token database. (See, e.g., Specification, Figure 4, and related text at 6:27-7:14.)

E. Independent Claim 20

Independent claim 20 is directed to a system which verifies a voucher or a token. The system includes means for recording a code associated with the voucher or token. (See, e.g., Specification, Figure 4, showing Voucher Printer 412, and related text at 6:27-7:1, and 7:25.) The system further includes means for scanning the voucher or token to retrieve the code at a cashier's station. (See, e.g., Specification, Figure 3 identifying Voucher Scanner 300, and related text at 5:26-6:13.) The system of independent claim 20 additionally includes means for querying a voucher or token database for information associated with the code. (See, e.g., Specification, Figure 3 identifying Controller 304, First Modem 316, and First Transceiver 312; and/or Figure 4 identifying Second Transceiver 400, Second Modem 416, and Processor 420, and related text at 8:8-11.) In addition to the foregoing features, the system of claim 20 also includes means for determining whether the voucher or token is valid, using the information. (See, e.g., Specification, 8:10-14; and, see also, Figure 1 identifying Control Center 124, and related text at 9:5-12.) Claim 20 further recites that the cashier's station uses a first communication link coupled to a back room computer, but the querying means uses a second communication link different from the first communication link. (See, e.g., Specification, Figure 1 illustrating link between Cashier's Station 108 and Back Room Computer 104, and Figures 3 and 4 identifying the First Modem 316 and the First Transceiver 312 of the voucher recognition subsystem 112, and the Second Modem 416 and the Second Transceiver 400 of the Coin-counting Kiosk 116.)

F. Claim 32

Independent claim 32 is directed to a method for verifying the validity of vouchers or tokens. The method includes recording a code and a value associated with the voucher or token. (See, e.g., Specification, Figures 5-7, 7:25-26, 8:22-23, and 9:17-18.) The method further includes reading the value or token to retrieve the code at a cashier's station, and determining the value associated with the code. (See, e.g., Figures 5-7, 8:4-11, 9:1-28.) In addition to the foregoing steps, the method of claim 32 also includes redeeming the

value associated with the code. (See, e.g., Specification, Figures 5-8, 8:12-16, 9:11-28, and 10:17-19.) Claim 32 additionally recites that the cashier's station uses a first communication link coupled to a back room computer, but the determining step uses a second communication link different from the first communication link. (See, e.g., Specification, Figure 1 identifying a first communication link between the Cashier's Station 108 and the Back Room Computer 104, and a second communication link between the Voucher Recognition Subsystem and the Coin-counting Kiosk; and 4:26-28 and 5:5-12.)

G. Claim 37

Independent claim 37 is directed to a method for verifying the validity of vouchers or tokens, and includes features at least generally similar to corresponding features of independent claim 32. For example, the method of claim 37 includes recording a value associated with the voucher or token. Claim 37 differs from claim 32, however, in that claim 37 includes reading the voucher or token to retrieve the value at a cashier's station. (See, e.g., Specification, 11:10.) The method of claim 37 further includes verifying the value associated with the voucher or token. (See, e.g., Specification, 11:11-14.) The method also includes redeeming the value associated with the code, and recites that the cashier's station uses a first communication link coupled to a back room computer, but the verifying step uses a second communication link different from the first communication link.

H. Claim 38

Independent claim 38 is directed to a method for verifying the validity of vouchers or tokens. The method includes purchasing merchandise at a cashier's station which uses a first communication link with a back room computer. (See, e.g., Specification, Figures 1 and 5-8, 5:5-17.) The method further includes a step for storing, in a database, at least one of a code and value associated with a voucher or token. (See, e.g., Specification, Figures 5-8, 7:25-26, 8:23.) Claim 38 also includes a step for reading the code from the voucher or token using a recognition subsystem. (See, e.g., Figures 5-8, 8:4-5, 9:1-2 and 20-21.) The method of claim 38 further includes a step for verifying the at least one of the

code and the value using a second communication link, which couples the database to the recognition subsystem. (See, e.g., Specification, Figures 5-8, 8:6-13.)

I. Independent Claim 40

Independent claim 40 is directed to a system which verifies a voucher or token. The system includes a cashier's station which uses a first communication link with a back room computer. (See, e.g., Specification, Figure 1, 4:19-20, 5:5-8.) The system of claim 40 further includes a voucher or token database and a recognition subsystem. The voucher or token database stores a unique code and a value associated with the voucher or token. (See, e.g., Specification, Figure 4, 6:27-7:1, 5:27-6:4.) The recognition subsystem reads the code from the voucher or token. (See, e.g., Specification, Figures 1 and 3, 5:26-6:13.) The system of claim 40 additionally includes a modem and first and second transceivers. The modem is coupled to the recognition subsystem for electronic verification of the voucher or token. (See, e.g., Specification, Figure 3, 6:14-22.) The first and second transceivers form a second communication link between the voucher or token database and the recognition subsystem. (Specification, Figures 1, 3 and 4, 4:26-5:1, 6:21-22, and 8:6-7.)

VI. GROUNDS OF OBJECTION TO BE REVIEWED ON APPEAL

(A) The Examiner has rejected claims 1-42 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,736,725 to Burns et al. ("Burns") in view of U.S. Patent No. 6,318,536 to Korman et al. ("Korman").

VII. ARGUMENT

A. The Section 103 Rejection of Claims 1-41

Claims 1-41 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Burns in view of Korman. To establish a *prima facie* case of obviousness, the prior art references must teach or suggest all of the claimed features. (M.P.E.P. § 706.02(j); emphasis added.) In the present case, Burns and Korman do not teach or suggest all the

claimed features. For example, as explained in greater detail below, neither Burns nor Korman teach or suggest a voucher or token verification system that includes a cashier's station as set forth in the pending claims. More specifically, neither Burns nor Korman teach or suggest a cashier's station that uses a first communication link to communicate with a back room computer and a second communication link to query a voucher or token database.

Not only do the applied references fail to teach or suggest all claimed features, but the applied references also fail to provide any suggestion or motivation to make the combination proposed by the Examiner. Hence, any construction of the seemingly random elements from the applied references to produce the claimed invention can only be viewed as "a thinly veiled use of impermissible hindsight." *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1050-51 (Fed. Cir. 1988). In fact, the applied references actually teach away from each other because Korman teaches a "coin machine" while Burns teaches a gaming system that "avoids having to use coins" (Korman, Abstract; Burns, Abstract; emphasis added.)

Under the well established standard for a *prima facie* case of obviousness, the Examiner must (1) identify prior art references that disclose all the elements of the claims, and (2) provide a suggestion or motivation (from the prior art) to combine the references to produce the claimed invention. (M.P.E.P. § 2143.) In the present case, the Examiner has failed to satisfy his initial burden of presenting a *prima facie* case of obviousness. Accordingly, the pending claims should be allowed.

1. Independent Claim 1 Is Directed to a Method for Verifying a Voucher or Token at a Cashier's Station That Uses a First Communication Link to Communicate With a Back Room Computer and a Second Communication Link to Query a Voucher or Token Database

Independent claim 1 is directed to a method for verifying a voucher or token at a cashier's station. The method includes recording a code associated with the voucher or token, and scanning the voucher or token at the cashier station to retrieve the code. As

claim 1 specifies, the cashier's station uses a first communication link to communicate with a back room computer, and a second communication link *different from* the first communication link to query a voucher or token database for information associated with the code. The method of claim 1 further includes using the information from the database to determine whether the voucher or token is valid.

2. Burns Discloses a Coinless Gaming System Having a Stand-alone Host Computer

As shown in Figure 1, Burns discloses a coinless gaming system 10 having a host central processing unit (CPU) 100 connected to a series of slot machines 200. (Burns, column 5 at lines 30-40.) The individual slot machines 200 include a paper currency reader 204, a bar code reader 206, and a bar code printer 208. In operation, a user inserts currency into the paper currency reader 204 or a voucher into the bar code reader 206. The currency reader 204 and/or the bar code reader 206 determines the credit available to the user.

When the user is done gambling at the slot machine 200, the bar code printer 208 prints a cash-out slip 220 having a bar code 222. The bar code 222 represents the monetary value of the credit stored in the particular slot machine 200, along with a randomly generated number used to verify the validity of the cash-out slip 220. (Burns, Figure 2 and column 6.) The user can then take the cash-out slip 220 and insert it into the bar code reader of another slot machine 200 and continue gambling. Alternatively, the user can take the cash-out slip 220 to a change station 300 to receive his or her winnings. (Burns, column 7.) The change station 300 is connected to the host CPU 100, which authenticates the cash-out slip 220 by examining the randomly generated number printed on the cash-out slip.

3. Korman Teaches a Multi-transaction Coin Machine

Korman discloses a coin machine that accepts a number of coins, counts the coins, and displays the value to a user. The user is then presented with a variety of options for

the cash value of the coins, including performing a financial transaction, purchasing tickets, or receiving a redeemable receipt. More specifically, as shown in Figure 1, Korman discloses a coin-counting kiosk 10 that includes a central computer 74 (Figure 4). Referring to Figure 5, the central computer 74 is networked to a remote host computer that communicates with a plurality of remote terminals (e.g., ATM/POS networks, airline reservation systems, movie ticket systems, lottery ticket systems, etc.).

In operation, the kiosk 10 prompts the user for information regarding the desired transaction. After receiving user input, the kiosk 10 transmits the information to the remote host computer. The remote host computer translates the instructions to the appropriate protocol, and then contacts the corresponding remote terminal. Upon receiving information back from the remote terminal, the host computer translates the information into a new format if necessary, and then transmits the information back to the originating kiosk 10. In a non-networked environment, the central computer 74 in each individual kiosk 10 would communicate directly with the remote terminals, and perform any necessary protocol translations itself. (Korman, column 11, lines 5-13.)

4. Neither Burns nor Korman Teach or Suggest a Method of Voucher or Token Verification that Includes Scanning the Voucher or Token at a Cashier's Station that Uses a First Communication Link to Communicate with a Back Room Computer and a Second Communication Link, Different from the First Communication Link, to Query a Voucher or Token Database

Claim 1 is directed to a method for verifying a voucher or token at a cashier's station. The cashier's station uses a first communication link to communicate with a back room computer and a second communication link to query a voucher or token database for information about a code associated with the voucher. Neither Burns nor Korman teach or suggest these features. Indeed, even the Examiner acknowledges that Burns fails to teach the second communication link of claim 1. (Final Office Action of May 19, 2005, page 5, lines 7-10.) In an attempt to fill the void in Burns, however, the Examiner turns to Korman.

But Korman also fails in this regard. For example, nowhere does Korman teach or suggest a communication link from a "cashier's station," as called for by claim 1. The most Korman teaches in this respect is a communication link from a "kiosk." Certainly, the "kiosk" of Korman cannot reasonably be construed as the "cashier's station" of claim 1. More to the point, such a flexible interpretation of "cashier's station" cannot be what was contemplated by the M.P.E.P.'s instruction to the Examiner to "identify prior art references that disclose all the elements of the claims." (M.P.E.P. § 2143.)

Furthermore, nowhere does Korman teach or suggest the second communication link of claim 1 that queries a "voucher or token database" for "information associated with [a] code" on the voucher. Instead, as Korman clearly states, his kiosk transmits "user-entered information" (not "voucher queries") to the remote host computer and/or remote terminal. Nowhere does Korman teach that the "user-entered" information can include a query for a "voucher or token database." Therefore, Burns and Korman, either alone or in combination, fail to teach or suggest all the features of claim 1. Accordingly, the Section 103 rejection of claim 1 is improper and should be reversed for at least this reason.

5. The Prior Art Provides No Motivation or Suggestion to Combine the Coinless Gaming System of Burns with the Multi-transaction Coin Machine of Korman

Claim 1 is patentable over the applied references for the additional reason that there is no motivation or suggestion within the references themselves for the Examiner's proposed combination. More specifically, in addition to the requirement that the applied references teach or suggest all the claimed features, the M.P.E.P. also requires that the "teaching or suggestion to make the claimed combination, and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure." (M.P.E.P. § 706.02(j); emphasis added.) Further, "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." *In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992) (emphasis added).

In the present case, even assuming (and applicant expressly does not) that the applied references do teach all the claimed features, the Examiner still has not complied with the M.P.E.P. and (1) identified where the prior art suggests combining the coinless gaming system of Burns with the multi-transaction coin machine of Korman, or (2) set forth an explanation of why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification. Instead, the Examiner has simply offered his own opinion that because both references teach "system and method of accepting coins, counting cons [sic], and dispensing a valid voucher for later redemption," they both "have the motivation to establish a *prima facie* case of obviousness." (Final Office Action, page 2, paragraph 3.) The Examiner's unsupported and conclusory assertions about combining the various features of the Burns and Korman references fail to satisfy the basic requirements for a proper *prima facie* obviousness rejection for at least the reason that these statements say nothing of substance about where the applied references actually suggest the claimed combination, or why one of ordinary skill in the art at the time the invention was made would have been motivated to modify the applied references as suggested by the Examiner.

In fact, the prior art does not suggest the desirability of combining Burns with Korman. To the contrary, the prior art teaches away from the proposed combination because Burns is specifically directed to a "coinless" gaming system, while Korman is directed to a coin machine. More specifically, the purpose of Burns' invention is to overcome the shortcomings of coin-operated machines, and Burns goes to great lengths to explain the shortcomings of coin-operated machines such as Korman's device. (See, e.g., Burns column 1, lines 10-59; "the use of coins in the casino operation for the playing of slot machines has presented a great number of well-known problems") In view of Burns' express goal of avoiding the use of coins, it is unreasonable to suggest that one of ordinary skill in the art, at the time the invention was made (and without hindsight of the applicant's invention) would somehow be motivated to combine the coinless system of Burns with the coin machine of Korman.

Furthermore, the coinless system of Burns is "closed" to prevent fraud. More specifically, the slot machines 200 of Burns are connected only to the CPU 100 within the casino, and the CPU 100 is connected only to the change station (also located within the casino). Burns' system is constructed in this way to mitigate the likelihood of fraud because it is more difficult for unauthorized users (e.g., hackers) to gain access to a closed system. Conversely, the kiosk in Korman's system is operatively connected to a plurality of remote terminals in a way that increases the likelihood that unauthorized users can gain access to the system. Thus, one of ordinary skill in the art would not be motivated to combine the open system of Korman with the closed system of Burns. Accordingly, the Section 103 rejection of claim 1 is improper and should be reversed for at least this additional reason.

Claims 2-4 and 7-12 depend from base claim 1. Accordingly, the Section 103 rejection of claims 2-4 and 7-12 is improper and should be reversed for the reasons discussed above with reference to base claim 1, and for the additional features of these dependent claims.

Independent claims 32 and 37 are directed to methods for verifying the validity of vouchers or tokens, and include several features generally similar to corresponding features of claim 1. Independent claim 20 is directed to a system which verifies a voucher or token, and also includes several features generally similar to corresponding features of claim 1. Accordingly, the Section 103 rejection of independent claims 20, 32 and 37 is improper and should be reversed for the reasons discussed above with reference to claim 1, and for the additional features of these independent claims.

Claims 21-31 and 41 depend from base claim 20, and claims 33-36 depend from base claim 32. Accordingly, the Section 103 rejection of dependent claims 21-31, 41 and 33-36 is improper and should be reversed for the reasons discussed above with reference to base claims 20 and 32, and for the additional features of these dependent claims.

6. Independent Claim 5 Is Directed to a Method for Verifying a Voucher or Token that Includes, *Inter Alia*, Querying a Voucher or Token Database in a Kiosk for Information Associated with a Voucher Code

Independent claim 5 is similar to claim 1, but further recites "the querying step includes querying a kiosk which includes at least a portion of the voucher or token database." Neither Burns nor Korman teach or suggest "a kiosk which includes at least a portion of a voucher or token database." In spite of this, the Examiner asserts that Burns does teach the limitations of claim 5, and directs the applicant to see column 2, lines 55-66, column 6, lines 48-55, and column 8, lines 11-17 of Burns. (Final Office Action, page 6 at paragraph 15.) After a close reading of the cited text, however, the undersigned attorney is at a complete loss to understand how it supports the Examiner's assertion that Burns teaches "querying a kiosk which includes at least a portion of the voucher or token database."

Assuming the Examiner is somehow construing the slot machine 200 of Burns as the "kiosk" of claim 5, and the CPU 100 of Burns as the "voucher or token database," the cited text merely reinforces what is clearly illustrated in Figure 1 of Burns, namely, that the slot machine 200 is *remote from* the CPU 100. More to the point, in column 5 at lines 33-35, Burns explicitly defines the CPU 100 as "a stand-alone computer...." (Emphasis added.) In light of Burns' explicit teaching that the CPU 100 is a "stand-alone computer," it is unreasonable to assert that the slot machines 200 disclosed by Burns somehow include the CPU 100, as suggested by the Examiner. Therefore, the combination of Burns and Korman can not support a proper *prima facie* case of obviousness for at least this additional reason, and the Section 103 rejection of independent claim 5 should be reversed.

Claim 6 depends from base claim 5. Accordingly, the Section 103 rejection of claim 6 is improper and should be reversed for the reasons discussed above with reference to base claim 5, and for the additional features of this dependent claim.

7. Independent Claim 13 Is Directed to a Voucher or Token Verification System that Includes a First Communication Link Between a Cashier's Station and a Back Room Computer, and a Second Communication Link Formed by First and Second Transceivers Between a Recognition Subsystem and a Voucher or Token Database

Independent claim 13 is directed to a system for verifying a voucher or token. The system includes a cashier's station that uses a first communication link with a back room computer, and a second communication link with a voucher or token database. Importantly, claim 13 recites that the second communication link is formed by first and second transceivers.

As discussed above, neither Burns nor Korman teach or suggest "a cashier's station" that includes (1) "a first communication link with a back room computer" and (2) "a recognition subsystem which uses a second communication link with a voucher or token database." In addition to lacking these features, the applied references also lack the "first and second transceivers which form [the] second communication link." Furthermore, nowhere in the final Office Action does the Examiner direct the applicant to any portion of either Burns or Korman that teaches or suggests the "first and second transceivers."

To fill this void, the Examiner makes the conclusory assertion that "it is clear that one of ordinary skill in the art would be able to modify any type of communication . . . to be used to communicate between a point-of-sale terminal (POS) and the issuing kiosk . . ." (Final Office Action at page 5, paragraph 3.) Regardless, the ability to modify a reference to arrive at the claimed invention (in hindsight of the applicant's disclosure) is not the proper legal standard for a *prima facie* case of obviousness. The law is clear: "The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." *In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992) (emphasis added). In the present case, not only has the Examiner failed to identify where the prior art includes the transceiver feature of claim 13, but the Examiner has also failed to identify where the prior art suggests the desirability of making the proposed modification. Accordingly, the Section

103 rejection of claim 13 is improper for at least these reasons, and the rejection should be reversed.

Claims 14-17 and 19 depend from base claim 13. Accordingly, the Section 103 rejection of claims 14-17 and 19 is improper and should be reversed for the reasons discussed above with reference to base claim 13, and for the additional features of these dependent claims.

Independent claim 18 includes several features that are at least generally similar to corresponding features of claim 13. Furthermore, claim 18 further specifies that at least a part of the voucher or token database is located in "a kiosk which includes a coin-counting mechanism." As set forth above in regard to independent claim 5, nowhere does Burns or Korman teach or suggest a coin-counting kiosk that includes a voucher or token database. Indeed, Burns does not even discuss a coin-counting mechanism. Further, Burns explicitly teaches that the CPU 100 is remote from the slot machines 200. Therefore, the Section 103 rejection of independent claim 18 is improper and should be reversed for at least the reason that neither of the applied references teach or suggest a coin-counting kiosk with a voucher or token database, and/or a second communication link formed by first and second transceivers.

Independent claim 40 is directed to a system for verifying a voucher or token that includes several features at least generally similar to corresponding features of claim 13. Accordingly, the Section 103 rejection of claim 40 is improper and should be reversed for at least the reasons discussed above with reference to claim 13, and for the additional features of claim 40.

8. Independent Claim 38 Is Directed to a Method for Verifying Vouchers or Tokens that Includes, *Inter Alia*, a Step for Purchasing Merchandise at a Cashier's Station That Uses a First Communication Link, and a Step for Verifying at Least One of a Code and a Value with a Recognition Subsystem That Uses a Second Communication Link

Independent claim 38 is directed to a method for verifying vouchers or tokens, and includes several features at least generally similar to corresponding features of claim 1. In addition, however, independent claim 38 further includes "a step for purchasing merchandise at a cashier's station." Nowhere do Burns or Korman teach or suggest this feature. Further, nowhere does the Examiner even address this feature of claim 38 in the final Office Action.

To establish a *prima facie* case of obviousness, the Examiner must identify prior art references that disclose all the elements of the claims. (M.P.E.P. § 2143.) The Examiner has failed to satisfy this burden with regard to independent claim 38 for at least the reason that the Examiner has not identified a single prior art reference that discloses "a step for purchasing merchandise at a cashier's station which uses a first communication link with a back room computer." Therefore, the Examiner's proposed combination of Burns and Korman fails to meet the basic criteria for defining even a *prima facie* basis for a Section 103 rejection. Accordingly, the Section 103 rejection of independent claim 38 should be reversed.

Claim 39 depends from base claim 38. Accordingly, the Section 103 rejection of dependent claim 39 is improper and should be reversed for the reasons discussed above with reference to base claim 38, and for the additional features of this dependent claim.

VIII. CLAIMS

A copy of the claims involved in the present appeal is attached hereto as Appendix A.

IX. EVIDENCE

No evidence pursuant to §§ 1.130, 1.131, or 1.132 or entered by or relied upon by the examiner is being submitted. Accordingly, no Evidence Appendix is included herewith.

X. RELATED PROCEEDINGS

No related proceedings are referenced in Section II above; hence no Related Proceedings Appendix is included herewith.

CONCLUSION

Each of claims 1-41 has been improperly rejected because (a) the applied references, either singularly or in combination, fail to disclose or suggest all the features of the pending claims, and (b) the Examiner has not provided any motivation or suggestion to combine Korman with Burns that is not based on hindsight of the claimed invention. Accordingly, the applicant respectfully requests that the rejection of the pending claims be reversed.

Dated: Jan 19, 2006

Respectfully submitted,

By 

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APPENDIX A

Claims Involved in the Appeal of Application Serial No. 09/662,414

1. (Original) A method for verifying a voucher or token, comprising:
recording a code associated with the voucher or token;
scanning the voucher or token to retrieve the code at a cashier's station;
querying a voucher or token database for information associated with the code; and
determining whether the voucher or token is valid, using the information, wherein
the cashier's station uses a first communication link coupled to a back room
computer, but the querying step uses a second communication link different
from the first communication link.

2. (Original) A method for verifying a voucher or token, as claimed in Claim 1,
further including the step of:
providing a coin counting mechanism which is configured to receive, all at once, a
plurality of randomly oriented coins of multiple denominations and other
objects, discriminate the coins and output the voucher or token for an amount
related to the value of the coins.

3. (Original) A method for verifying a voucher or token, as claimed in Claim 1,
wherein:
the scanning step is performed with a recognition subsystem.

4. (Original) A method for verifying a voucher or token, as claimed in Claim 1,
wherein:
the recording step includes recording a value associated with the code.

5. (Previously Presented) A method for verifying a voucher or token, comprising:

recording a code associated with the voucher or token;

scanning the voucher or token to retrieve the code at a cashier's station;

querying a voucher or token database for information associated with the code,

wherein the querying step includes querying a kiosk which includes at least a portion of the voucher or token database; and

determining whether the voucher or token is valid, using the information, wherein the cashier's station uses a first communication link coupled to a back room computer, but the querying step uses a second communication link different from the first communication link.

6. (Original) A method for verifying a voucher or token, as claimed in Claim 5, wherein:

the recording step is performed in a remote location from the kiosk.

7. (Original) A method for verifying a voucher or token, as claimed in Claim 1, wherein:

the querying step includes querying a control center which includes at least a portion of the voucher or token database.

8. (Original) A method for verifying a voucher or token, as claimed in Claim 1, wherein:

the querying step is performed by a recognition subsystem.

9. (Original) A method for verifying a voucher or token, as claimed in Claim 1, wherein:

the voucher or token includes at least one of a magnetic strip, a bar code or a smartcard.

10. (Original) A method for verifying a voucher or token, as claimed in Claim 1, wherein:

the voucher or token is at least one of a phone card, a gift certificate, a mass transit pass, a travel ticket, a financial instrument and an event ticket.

11. (Original) A method for verifying a voucher or token, as claimed in Claim 1, further including the step of:

printing the voucher or token.

12. (Original) A method for verifying a voucher or token, as claimed in Claim 1, further including the step of:

counting coins with a coin counting mechanism in a kiosk, wherein at least a part of the database is located in the kiosk.

13. (Original) A system which verifies a voucher or token, comprising:

a cashier's station which uses a first communication link with a back room computer;

a voucher or token database which stores at least one of a code and a value associated with the voucher or token;

a recognition subsystem which reads the code from the voucher or token; and

first and second transceivers which form a second communication link, different from the first communication link, wherein the second communication link couples together the voucher or token database and the recognition subsystem.

14. (Original) A system which verifies a voucher or token, as claimed in Claim 13, wherein:

the code associated with a voucher or token is unique.

15. (Original) A system which verifies a voucher or token, as claimed in Claim 13, wherein:

the voucher or token database stores a value associated with the voucher or token.

16. (Original) A system which verifies a voucher or token, as claimed in Claim 13, wherein:

the transceivers communicate with at least one of the following techniques: wireless, carrier current, data over telephone voice systems and direct-wired communication.

17. (Original) A system which verifies a voucher or token, as claimed in Claim 13, further comprising:

a modem coupled to the recognition subsystem for electronic verification of the voucher or token.

18. (Previously Presented) A system which verifies a voucher or token, the system comprising:

a cashier's station which uses a first communication link with a back room computer;

a voucher or token database which stores at least one of a code and a value associated with the voucher or token;

a kiosk which includes a coin counting mechanism, wherein at least a part of the voucher or token database is located in the kiosk;

a recognition subsystem which reads the code from the voucher or token; and first and second transceivers which form a second communication link, different from the first communication link, wherein the second communication link couples together the voucher or token database and the recognition subsystem.

19. (Original) A system which verifies a voucher or token, as claimed in Claim 13, wherein:

the system is not coupled to a point of sale system.

20. (Original) A system which verifies a voucher or token, comprising:

means for recording a code associated with the voucher or token;

means for scanning the voucher or token to retrieve the code at a cashier's station;

means for querying a voucher or token database for information associated with the code; and

means for determining whether the voucher or token is valid, using the information,

wherein the cashier's station uses a first communication link coupled to a back room computer, but the querying means uses a second communication link different from the first communication link.

21. (Original) A system which verifies a voucher or token, as claimed in Claim 20, further comprising:

a coin counting mechanism which is configured to receive, all at once, a plurality of randomly oriented coins of multiple denominations and other objects, discriminate the coins and output the voucher or token for an amount related to the value of the coins.

22. (Original) A system which verifies a voucher or token, as claimed in Claim 20, wherein:

the scanning means includes a recognition subsystem.

23. (Original) A system which verifies a voucher or token, as claimed in Claim 20, wherein:

the recording means includes a second means for recording a value associated with the code.

24. (Original) A system which verifies a voucher or token, as claimed in Claim 20, wherein:

the querying means includes a second means for querying a kiosk which includes at least a portion of the voucher or token database.

25. (Original) A system which verifies a voucher or token, as claimed in Claim 24, wherein:

the recording means is located in a remote location from the kiosk.

26. (Original) A system which verifies a voucher or token, as claimed in Claim 20, wherein:

the querying means includes a second means for querying a control center which includes at least a portion of the voucher or token database.

27. (Original) A system which verifies a voucher or token, as claimed in Claim 20, wherein:

the querying means includes a recognition subsystem.

28. (Original) A system which verifies a voucher or token, as claimed in Claim 20, wherein:

the voucher or token includes at least one of a magnetic strip and a bar code.

29. (Original) A system which verifies a voucher or token, as claimed in Claim 20, wherein:

the voucher or token is at least one of a phone card, a gift certificate, a mass transit pass, a travel ticket, a financial instrument and an event ticket.

30. (Original) A system which verifies a voucher or token, as claimed in Claim 20, further comprising:

means for printing the voucher or token.

31. (Original) A system which verifies a voucher or token, as claimed in Claim 20, further comprising:

means for counting coins with a coin counting mechanism in a kiosk, wherein at least a part of the database is located in the kiosk.

32. (Original) A method for verifying the validity of vouchers or tokens, comprising:

recording a code and a value associated with the voucher or token;

reading the voucher or token to retrieve the code at a cashier's station;

determining the value associated with the code; and

redeeming the value associated with the code, wherein the cashier's station uses a first communication link coupled to a back room computer, but the determining step uses a second communication link different from the first communication link.

33. (Original) A method for verifying the validity of vouchers or tokens, as claimed in Claim 32, wherein:

the code contains at least a modem number of an issuing kiosk.

34. (Original) A method for verifying the validity of vouchers or tokens, as claimed in Claim 32, wherein:

the code is related to at least one of a printed voucher or token or a preexisting card.

35. (Original) A method for verifying the validity of vouchers or tokens, as claimed in Claim 32, further comprising the step of:
recording a residual value associated with the code after the redeeming step.

36. (Original) A method for verifying the validity of vouchers or tokens, as claimed in Claim 32, wherein:
the reading step is performed with at least one of a card reader, a smartcard reader and a bar code scanner.

37. (Original) A method for verifying the validity of vouchers or tokens, comprising:
recording a value associated with the voucher or token;
reading the voucher or token to retrieve the value at a cashier's station;
verifying the value associated with the voucher or token; and
redeeming the value associated with the code, wherein the cashier's station uses a first communication link coupled to a back room computer, but the verifying step uses a second communication link different from the first communication link.

38. (Previously Presented) A method for verifying the validity of vouchers or tokens, the method comprising:
a step for purchasing merchandise at a cashier's station which uses a first communication link with a back room computer;
a step for storing, in a database, at least one of a code and a value associated with a voucher or token;
a step for reading the code from the voucher or token using a recognition subsystem; and

a step for verifying the at least one of the code and the value using a second communication link, wherein the second communication link couples together the database and the recognition subsystem.

39. (Original) A method for verifying the validity of vouchers or tokens, as claimed in Claim 38, wherein:

the recognition subsystem is located at the cashier's station.

40. (Original) A system which verifies a voucher or token, comprising:

a cashier's station which uses a first communication link with a back room computer;

a voucher or token database which stores a code and a value associated with the voucher or token wherein the code associated with a voucher or token is unique;

a recognition subsystem which reads the code from the voucher or token;

a modem coupled to the recognition subsystem for electronic verification of the voucher or token; and

first and second transceivers which form a second communication link, wherein the second communication link couples together the voucher or token database and the recognition subsystem.

41. (Original) A system which verifies a voucher or token, as claimed in Claim 25, further comprising:

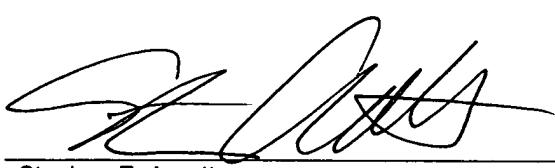
a kiosk which includes a coin counting mechanism and wherein at least a part of the voucher or token database is located in the kiosk.

42. (Cancelled)



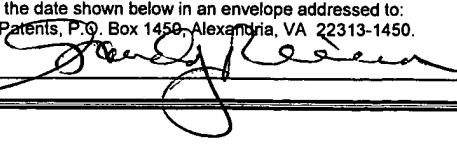
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TRANSMITTAL OF APPEAL BRIEF		Docket No. 213828015US1
In re Application of: Beach et al.		
Application No. 09/662,414-Conf. #9962	Filing Date September 14, 2000	Examiner K. Abdi
Invention: SYSTEM FOR VOUCHER OR TOKEN VERIFICATION		
<u>TO THE COMMISSIONER OF PATENTS:</u>		
Transmitted herewith is the Appeal Brief in this application, with respect to the Notice of Appeal filed: <u>September 19, 2005</u>		
The fee for filing this Appeal Brief is <u>\$ 500.00</u>		
<input checked="" type="checkbox"/> Large Entity <input type="checkbox"/> Small Entity		
<input type="checkbox"/> A petition for extension of time is also enclosed.		
The fee for the extension of time is <u>\$ 450.00</u>		
<input type="checkbox"/> A check in the amount of <u>\$ 950.00</u> is enclosed.		
<input type="checkbox"/> Charge the amount of the fee to Deposit Account No. <u>50-0665</u> This sheet is submitted in duplicate.		
<input type="checkbox"/> Payment by credit card. Form PTO-2038 is attached.		
<input type="checkbox"/> The Director is hereby authorized to charge any additional fees that may be required or credit any overpayment to Deposit Account No. <u>50-0665</u> This sheet is submitted in duplicate.		
		Dated: <u>January 19, 2006</u>
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I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EV784673665US, on the date shown below in an envelope addressed to: MS Appeal Brief - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Dated: January 19, 2006

Signature: 

(Sandy Reisman)